

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Douglas D. Sjostrom
Serial No. : 10/015,778
Filed : December 17, 2001
Title : CUTTING INSTRUMENT

Art Unit : 3731
Examiner : Victor X Nguyen

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Restriction

Responsive to the action mailed February 23, 2006, applicant elects the invention of Group II, claims 25-59, 64-65 and 70-77, drawn to the embodiment of a cutting instrument. The election is made without traverse.

Election of Species

The Examiner has indicated that the present application also contains the following patentably distinct species:

Species I, Figs. 1-6;
Species II, Fig. 7; and
Species III, Fig. 8.

Applicant elects Species I, Figs. 1-6, claims 24-39, 42-56, 59, 64-65 and 70-77, with traverse. In contrast to the Examiner's assertion that there are no generic claims, Applicant submits that independent claims 25, 42, 59, 64 and 65 are generic. Applicants submit that claims 40, 41, 57 and 58 should also be examined as these additional, non-elected claims would impose no additional burden on the Examiner and/or are directed at a reasonable number of species dependent from one or more generic claims.

Applicant submits that the election of species requirement is improper, particularly at this stage of prosecution. Section 806.04 of the MPEP describes the Examiner's authority to require election between one or more species in a pending application. Specifically, the MPEP clearly states:

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Attorney's Docket No.: 00167-456001 / 02-31-0385

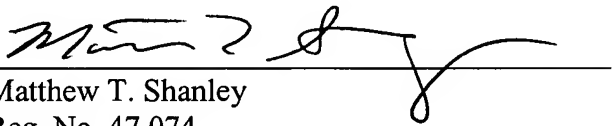
Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. However, 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby. The practice is set forth in 37 CFR 1.146.

Claims 25, 42, 49, 64 and 65 are generic and clearly link a reasonable number of species. The first sentence of 37 CFR 1.146 states, "In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby. . . ." The Examiner is reminded that the Office has previously issued six (6) office actions on the merits for the present application, and is therefore significantly removed from the "first action on an application." Further, the Office's six previous considerations of all three species is prima facie evidence that Species I-III are "a reasonable number of species." Accordingly, this election of species requirement should be withdrawn.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: April 13, 2006


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